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Stevens Davis Miller & Mosher  
1615 L Street, NW, Suite 850  
PO Box 34387  
Washington, DC 20043-4387

In re Application of	:	DECISION ON
SHI et al.	:	
Application No.: 09/701,309	:	PETITION UNDER
PCT No.: PCT/JP00/01754	:	
Int. Filing Date: 23 March 2000	:	37 CFR 1.47(a)
Priority Date: 31 March 1999	:	
Attorney Docket No.: L9289.00120	:	
For: COMMUNICATION TERMINAL	:	
APPARATUS, BASE STATION APPARATUS	:	
AND RADIO COMMUNICATION METHOD	:	

This is a decision on applicants' "RENEWED PETITION UNDER 37 C.F.R. § 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 19 October 2001.

### **BACKGROUND**

On 23 March 2000, applicants filed international application PCT/JP00/01754, which claimed a priority date of 31 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 12 October 2000. The twenty-month period for paying the basic national fee in the United States expired at midnight on 31 November 2000.

On 28 November 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than twenty months from the priority date.

On 26 December 2000, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required. The NOTIFICATION set a one-month extendable period for reply.

On 26 March 2001, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*: a petition/fee for a two-month extension of time; surcharge under 37 CFR 1.492(e); an authorization to charge any fees which may be required to Deposit Account 19-

4375; a declaration of inventors executed by two of the three joint inventors; a declaration of facts by Osamu Kato; cover letters of mailings sent to Mr. Shi on 08 February 2001 and 16 February 2001; and translations of Registered Record of Delivery for these mailings which indicate that these mailings were returned to the sender after a one-week custodial period due to absence of the recipient.

On 21 August 2001, the USPTO mailed a decision dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that sufficient factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort was not provided.

On 19 October 2001, applicants submitted the instant "RENEWED PETITION UNDER 37 CFR §1.47(a)", which was accompanied by, *inter alia*, a supplemental declaration of facts of Osamu Kato, a registered mail receipt (with English translation) for a delivery made to Mr. Shi on 17 September 2001, a "Record of Delivery" (with English translation) for recipient Mr. Shi, and a sample "Notice of Delivery" (with English translation).

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 21 August 2001, items (1), (3), and (4) have been met.

As to item (2), sufficient factual proof has now been provided that the missing joint inventor Mr. Shi cannot be reached after diligent effort. The application and papers have been reviewed and have been found to be in compliance with 37 CFR 1.47(a).

### CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.47(a) is GRANTED.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. 371(c) date of **26 March 2001**.



Daniel Stemmer  
Legal Examiner  
PCT Legal Affairs  
Office of Patent Cooperation Treaty  
Legal Administration  
Telephone: (703) 308-2066  
Facsimile: (703) 308-6459